



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify that this TERMINAL DISCLAIMER and documents submitted therewith are being deposited with the United States Postal Service on the date indicated below with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Nancy Barker

Nancy Barker

1/5/01

Date

Applicant: Maruyama, et al

Serial No.: 08/852,020

Filing Date: May 6, 1997

Title: LAMBDOID BACTERIOPHAGE VECTORS
FOR EXPRESSION OF FOREIGN
PROTEINS



) Group Art Unit: 1636

) Exam.: G. Leffers, Jr.

) Our Ref.: TSRI 432.0 D1

24

TERMINAL DISCLAIMER PURSUANT TO
37 CFR § 1.321

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Petitioner, The Scripps Research Institute, residing at 10550 North Torrey Pines Road, La Jolla, CA 92037, in the county of San Diego and State of California, represents that it is the assignee of the entire right, title and interest in and to the above-identified application as set forth in an assignment recorded on 10/24/94, on reel 7175, frame 0236.

Petitioner hereby disclaims the terminal part of any patent granted on the above-identified application which would extend beyond the expiration date of the full statutory term of U.S. Patent No. 5,627,024, issued 5/6/97, and hereby agrees that any patent so granted on the above-identified herein application shall be enforceable only for and during such period that the legal title

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to said patent shall be the same as the legal title to U.S. Patent No. 5,627,024, issued 5/6/97. This agreement is to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term of U.S. Pat. No. 5,627,024, as presently shortened by any terminal disclaimer in the event that one or more later: (1) expires for failure to pay a maintenance fee; (2) is held unenforceable; (3) is found invalid; (4) is statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321(a); (4) has all claims canceled by a reexamination certificate; or (5) is otherwise terminated prior to expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

The evidentiary documents accompanying or referred to in the instant Terminal Disclaimer have been reviewed by the undersigned and it is certified that to the best of Petitioner/Assignee The Scripps Research Institute's knowledge and belief, title is in the Petitioner/Assignee.

The undersigned represents that he is a representative duly authorized to sign on behalf of the Petitioner.

The undersigned declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Serial No.: 08/852,020

TSRI 432.0 D1

Respectfully submitted,

Dated: 1-5-01

By:

Thomas E. Northrup

Thomas E. Northrup, Reg. No. 33,268

THE SCRIPPS RESEARCH INSTITUTE
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Attorney or agent of
record

Filed under §1.34a

P:\NANCY\WP\OA\SCR1912P.TERM.DISCL.

SUBJECT DECISION ON TERMINAL DISCLAIMER INFORMAL FORM

DATE: 2-5-01

APPL. S.N.: 081852,020

TO EXAMINER: G Leffers

ART UNIT: 1636

MOSE MONTGOMERY ROOM 11E18

MAILROOM DATE 1-18-01

AFTER FINAL YES / NO / NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE IN LEFT IN FILE.

- The T.D. is PROPER and has been recorded. (See 14.23).
- The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).
- The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)
- Application Examiner has not processed T.D. fee. (See fee authorization).
- The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).
- The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).
- It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).
- The person who signed the terminal disclaimer:
 has failed to state his/her capacity to sign for the business entity, (See 14.28).
 is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).
- No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).
- No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).
- The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.
- Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).
- The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).
- The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).
- The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)
- Other: _____

Suggestion to request refund of \$ _____. (See 14.35, 14.36).

EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALITIES MAY BE FAXED IN TO THE GROUP

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

- Sample of a TD over a pending application and assignee Certificate (See 14.37).
 Sample of a TD over a prior patent and assignee Certificate (See 14.38).
 Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)